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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,783	09/11/2006	Rickard Carlsson	BERGLUNDS P0320 CIP	1331
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HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718			EXAMINER LAMB, BRENDA A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,783	Applicant(s) CARLSSON ET AL.	
	Examiner Brenda A. Lamb	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-40 is/are pending in the application.
- 4a) Of the above claim(s) 19-25,35,36,39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-34,37 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/31/08, 1/18/07</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicant's election with traverse of Group III in the reply filed on 10/31/2008 is acknowledged. The traversal is on the ground(s) that method for paper use in a device is linked to claim 26 via its dependency thereon. This is not found persuasive because WO 93/04622 and DE-39 22 159 A1 discloses the special technical feature of a paper dispensing device comprised of a sprayer for spraying the paper with a fluid arranged adjacent an outlet of the dispenser such that only the dispensed paper is wetted. Therefore, there is no unity of invention when the special technical feature is present in the prior art. Hence, lack of unit is held by the examiner in accordance with PCT Rule 13. Also see MPEP 1850 - Determination of unity of Invention. Note Group IV, claim(s) 36, is drawn to method for use of paper in a dispensing device whereas Group III, claim(s) 26-34 and 37-38, is drawn to dispensing device and the apparatus or device as claimed can be used to practice another and materially different process such as dispense non-paper or cloth sheets.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-34 and 37-38 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Feeding device which includes the roller arranged with rubber rings which is in contact with the paper on one side is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

A motor itself cannot feed the paper through the paper dispensing device rather the motor which provides the motive force for rotating a feeding roller in a feeding device that provides for movement of the paper.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 26-27 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is activated by the contact-free activation as set forth in claim 30. It is unclear how "the paper web" in claim 34 relates to the paper set forth in independent claim 26. It is unclear how "folded paper" in claim 27 relates to the paper set forth in independent claim 26.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 26-27 and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe 5,131,302.

Watanabe teaches the design of a dispenser which is comprised of the following elements: a motor drive for dispensing the paper; a sensor 34 for sensing movement of the user's hand in front of the sensor to provide contact free activation of dispensing of paper therefrom; a cutting tool (elements 24b,24a) for cutting the substrate to a desired length; and a feeding device including on a roller (elements 10,11) arranged with rubber rings that are in contact with paper. Watanabe dispenser is capable of dispensing a substrate within the scope of the claim since it teaches every element of the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus Watanabe teaches every element of the claimed apparatus as set forth in claims 26 and 30-33. With respect to claim 27, Watanabe teaches his apparatus includes folding substrate perpendicular to the longitudinal direction of the substrate.

Claims 26-29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazar 2002/0113163.

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Lazar teaches the design of a dispenser which is comprised of the following elements: a motor drive 21 for dispensing the paper; a cutting tool 35 for cutting the paper to a desired length; a sprayer or nozzle array 47 for spraying a material; and control electronics for feeding differently amount of liquid material on the substrate (see paragraph 0039-00400). Lazar dispenser is capable of dispensing a substrate within the scope of the claim since it teaches every element of the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus Lazar teaches every element of the claimed apparatus as set forth in claims 26, 28-29 and 32. With respect to claim 27, Lazor teaches his apparatus includes folding paper perpendicular to the longitudinal direction of the substrate (paragraph 0031).

Claims 26-29, 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen 5,265,509.

Chen teaches the design of a dispenser which is comprised of the following elements: a motor drive 50 for dispensing the substrate; a cutting tool 6 for cutting the substrate to a desired length; a sprayer or nozzle 34 for spraying a material; control electronics for feeding different amounts of material on the substrate (column 3 line 59 to column 4 line 14). Chen teaches his apparatus includes using a folded substrate

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perpendicular to the longitudinal direction of the substrate. Chen dispenser is capable of dispensing a substrate within the scope of the claim since it teaches every element of the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus Chen teaches every element of the claimed apparatus as set forth in claims 26-29 and 32. With respect to claim 34, Chen teaches that the perforator in his apparatus can include a knife with a number of adjacent knife tips or saw-toothed cutting edge.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen 5,265,509.

Chen is applied for the reasons noted above. Chen teaches at column 4 lines 20-26 that the dispenser is refillable without disposing of partly used stacks but fails to teach a paper magazine/paper chamber is refillable from below. However, it prima facie obvious to invert the Chen dispenser to insert the stack of folded paper/substrate into the bottom opening of the paper magazine/paper chamber to facilitate loading of the paper/substrate without contacting the guide rolling system 21 until the user is ready to feed the paper/substrate through the dispenser.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lazar 2002/0113163 in view of DiSanto.

Lazar is applied for the reasons noted above. Lazar teaches supporting liquid sources of material for its nozzles on a shelving system. Lazar fails to teach his shelving system is swivelable or pivotable. However, it would have been obvious to modify the Lazar paper dispensing system by pivotably or swivelably mounting its shelving system since DiSanto teaches pivotably or swivelably mounting its shelving system in a housing system to obviously enable one provide greater access of the interior of the housing (see DiSanto at column 2 lines 13-23).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton, can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Brenda A Lamb
Primary Examiner
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/Brenda A Lamb/

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